

REMARKS

Upon entry of the amendments, claims 1-20 will be pending in the application. The Examiner has allowed claim 14 and stated that claim 17 contains allowable subject matter. The Examiner has rejected claims 1-13, 15, 16, and 18-20.

Upon careful consideration of the Office Action, Applicants provide the following comments.

Claim Rejections – 35 U.S.C. § 112

Claim 10 is rejected under the second paragraph of 35 U.S.C. § 112 as indefinite due to improper Markush language. Applicants have amended the claims to insert the proper language. Hence, Applicants request that this rejection be withdrawn.

Claim Rejections – 35 U.S.C. § 103

Claims 1-7 and 9, 10, 12, 13, 15, 16 and 18-20 are rejected as obvious in view of Lapin (US 5,139,872) or Liu (US 5,139,872) in view of Nair (US 6,308,001) or Hirose (US 4,694,052). The Office Action sets forth that Lapin and Liu teach the vinyl ether terminated monomers and a photopolymerization for optical coatings. The Office Action also sets forth that Nair and Hirose teach the use of fillers in coating compositions. The Office Action details that modifying Lapin or Liu in view of Nair and Hirose would be obvious because Lapin and Liu teach the use of additives, which could be fillers.

Applicants have carefully considered this rejection and request that it be withdrawn. Applicants have the following comments regarding the cited prior art.

Lapin relates to coating compositions for optical fibers, which may be prepared from compositions containing vinyl ether oligomer prepared by reacting a hydroxyl-terminated polyester or polyether, a diisocyanate and a hydroxyl monovinyl ether, with mono or multifunctional vinyl terminated monomers, which may be derived from esters or alcohols. Applicants note that Lapin teaches the use of additives like dyes, stabilizers, hindered phenol antioxidants, photosensitizers, and other components familiar to one skilled in the art. However, there is no teaching, hint, or suggestion that fillers would be utilized. It is also questionable why someone skilled in the art would use fillers in Lapin's coating composition for optical fibers.

Likewise, Liu fails to disclose the presence of a filler as noted in the Office Action. Liu relates primarily to aryloxy polyvinyl ethers.

Applicants respectfully submit that the failings of the aforementioned primary references, Lapin and Liu, are not alleviated upon consideration of the secondary references, Nair and Hirose.

Nair discloses fluorinated vinyl ether compounds, which may have additives. The additives could potentially include fillers and the total amount of additives ranges from 0 to 6% based on the total composition weight. There is no disclosure regarding the total amount of fillers out of the aforementioned percentage and Nair advises that the amount of additives varies depending on the end use of the coating composition, i.e. their use on optical fibers.

Hirose discloses a coating composition that contains a urethane-modified (meth)acrylate compound and a mono(meth)acrylate, which is not the object of the present invention. Hirose details that fillers could potentially be used.

Regarding independent claim 1 and the subsequent dependant claims, Applicants respectfully submit that the rejection be withdrawn. The cited prior art fails to detail dental

material. This feature does not merely appear in the preamble as asserted in the Office Action. This feature appears in the body of the claim. This feature should be given patentable weight.

Further, the determination of whether a preamble limits a claim is made on a case-by-case basis in light of the facts in each case; there is no litmus test defining when a preamble limits the scope of a claim. "[A] claim preamble has the import that the claim as a whole suggests for it." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). The claims are directed towards a dental material that has certain components, not to an optical fiber coating.

Applicants also question the motivation for the proposed combination. Neither of the primary references detail the use of fillers. There does not appear to be any suggestions in the cited prior to perform the combination proposed in the Office Action. The standard for determining obviousness is not an "obvious to try" standard. *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988). The prior art does not give any indication of which parameters are critical or any direction to one skilled in the art absent the potential use of fillers in optical fiber coatings.

The fillers utilized in the invention impart unexpected results. Applicants detail in the specification the unexpected results that derive from the invention set forth in claim 1. The invention has slight shrinkage, excellent mechanical characteristics, and a good polishing

capacity of the cured material. These unexpected results overcomes long felt problems in the prior art, which are discussed in the specification.

Furthermore, Applicants submit that the prior art fails to disclose the ranges set forth in claims 12 and 13.

Claims 1-7, 9-13, 15, 16, and 18-20 are rejected as obvious in view of Lapin or Liu in view of Nair or Hirose, in further view of Yang (US 5,969,000). Applicants respectfully submit that this rejection should be withdrawn for the reasons set forth in regards of the first obviousness rejection. The cited prior art fails to teach all of the features of the claimed dental material and there is insufficient motivation for the proposed combination. Consideration of Yang does not alleviate the aforementioned failings.

Yang relates to an ethoxylated bisphenol A dimethacrylate together with a methacrylate oligomer and an optional dileunt monomer, which is not the object of the present invention. It would not be obvious to one skilled in the art to utilize the filler of Yang in the other prior art references.

Claims 1-10, 12, 13, 15, 16, and 18-20 are rejected as obvious in view of Lapin or Liu in view of Nair or Hirose, in further view of Palazzoto (US 4,889,792) or Levy (US 6,042,943). Applicants respectfully submit that this rejection should be withdrawn for the reasons set forth in regards of the first obviousness rejection. The cited prior art fails to teach all of the features of the claimed dental material and there is insufficient motivation for the proposed combination. Consideration of Palazzoto or Levy does not alleviate the aforementioned failings.

Applicants also set forth that Palazzota relates to a photopolymeric composition comprising one vinyl monomer capable of undergoing free-radical polymerization and a photo-

initiator system. The present invention comprises a cationically polymerizable monomer.

Whereas, Levy is directed towards a radiation curable primary coating composition for an optical fiber.

Applicants respectfully submit that the rejections should be withdrawn because the Office Action does not set forth a *prima facie* case of obviousness.

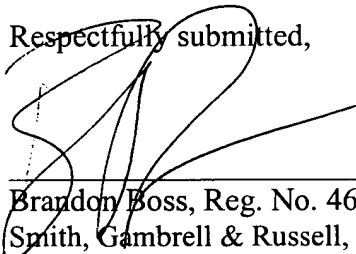
CONCLUSION

Applicants respectfully request allowance of the application. If any additional fees are due in connection with the filing of this response, such as fees under 37 C.F.R. §§ 1.16 or 1.17, please charge the fees to Deposit Account No. 02-4300. Any overpayment can be credited to Deposit Account No. 02-4300.

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Signature:

Respectfully submitted,



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